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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER PATTERSON, MARIE D	
			ART UNIT 3728	PAPER NUMBER
DATE MAILED: 09/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/994,059	Applicant(s) QUELLAIS ET AL.	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

1. Claims 17-20, 22, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17 the phrase "said rigid intermediate layer.....a succession of rigid inserts...", in claim 19 the phrase "...two arc-shaped recesses...", in claim 24 the phrase "which pass through said intermediate layer, or rib...." contradict the limitation of "said intermediate layer extending over an entire surface of said ground contacting layer" as claimed in claim 1 from which these claims depend rendering the claims confusing, vague, and indefinite.

In claim 22 the phrases "a principal mechanical ground-gripping zone", "a secondary position-maintenance or gripping zone" and "neutral central rear zone" are confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 28 is rejected under 35 U.S.C. 102(a or e) as being anticipated by Tong (5185943).

Tong shows a shoe comprising a laminated profile sole comprising a ground contacting layer (118), an upper comfort layer (116), and an intermediate layer (120) which extends "over substantially an entire surface of said ground contact layer" as claimed.

4. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Barry (5052130).

Barry shows a shoe comprising a laminated sole comprising a ground contacting layer (16), a comfort layer (18), and an intermediate layer (20) which covers "substantially" an entire area of the ground contacting layer as claimed.

5. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Giese (5025573).

Giese shows a shoe comprising a laminated sole comprising a ground contacting layer (elements shown in figures 122-126 below element 31), a comfort layer (elements above element 31, note description on column 10, lines 1-33), an intermediate layer

(31) "extending over substantially an entire surface of said ground contact layer" and which comprises in the metatarsal area, a succession of rigid inserts (31A) as claimed.

6. Claims 1, 2, 14-16, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuoka (4079526).

Fukuoka shows a sole comprising an intermediate layer (25), a ground contacting layer (35), and a cushion layer formed by points (29, 33, and 31) inasmuch as the claims and specification are understood.

7. Claims 1, 19, 20, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Salzman (4186500).

Salzman shows a sole comprising a ground contacting layer (11) which is molded and forms arc shaped stops at the toe and heel portions in "recesses" of an intermediate layer (30) which covers "the entire" ground contacting surface, and a comfort layer (50) inasmuch as the claims are understood.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 17, 18, 28, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of Giese (5025573).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a

comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering substantially the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accommodate different running styles, let and foot asymmetries and body weights" (column 10 lines 37-46). Giese teaches extending a rigid intermediate layer (31) into the metatarsal area and forming the metatarsal area as a succession of rigid inserts (31A). It would have been obvious to extend the intermediate layer into the metatarsal area and to form such as a succession of rigid inserts as taught by Giese in the sole of Misevich to increase support into the metatarsal area without reducing the flexibility of the metatarsal area.

10. Claims 1, 2, 4-14, 21-23, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of Kurrash (4580359).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a

comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accommodate different running styles, let and foot asymmetries and body weights" (column 10 lines 37-46). Kurrash teaches extending a substantially rigid support layer (36) to cover the entire surface of a ground contacting layer. It would have been obvious to extend the intermediate support layer to cover the entire surface of the ground contacting layer as taught by Kurrash in the shoe sole of Misevich to increase the geometrical extent/area covered by the stiffening formation as suggested by Misevich to increase the support/stiffness in the forefoot area of the shoe.

In reference to claims 5-10, Misevich as modified above discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the materials claimed, since it has been held to be within the general skill of a worker in the art to select a

known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

11. Claims 1, 2, 4-14, 21-22, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of Hannibal (4651445).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accommodate different running styles, let and foot asymmetries and body weights" (column 10 lines 37-46). Hannibal teaches extending a substantially rigid support layer (30) to cover the entire surface of a ground contacting layer. It would have been obvious to extend the intermediate support layer to cover the entire surface of the ground contacting layer as taught by either Hannibal in the shoe sole of Misevich to increase the geometrical



extent/area covered by the stiffening formation as suggested by Misevich to increase the support/stiffness in the forefoot area of the shoe.

In reference to claims 5-10, Misevich as modified above discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the materials claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

intermediate support layer to cover the entire surface of the ground contacting layer as taught by

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4-14, 21-23, and 25-28 above, and further in view of Banich.

Misevich as modified above shows a shoe sole substantially as claimed except for the comfort layer having different areas of elasticity. Banich teaches providing a midsole (figure 4) having zones of different material properties. It would have been obvious to provide the comfort layer with zones as taught by Banich in the shoe sole of Misevich as modified above to improve stability and natural biomechanics of the foot.

### ***Response to Arguments***

13. Applicant's arguments filed 3/8/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the 112 second paragraph rejections, the phrases in claims 17, 19, and 24 as designated above, clearly contradict the limitation of the intermediate layer extending over the "entire" surface. It is noted that the addition of the term "entire" in the original application was done at a time when the dependent claims 17, 19, and 24 were withdrawn from examination and the fact that the Examiner at the time failed to note that these claims were indefinite is not persuasive. In response to applicants' arguments directed towards the latitude benefit of language in a claims, this is true, however due to the vagueness and misunderstanding present in the arguments of this application do show that the actual structural limitations applicant intends to encompass with the language in claim 22 and the phrase "substantially entire" in other claims are unclear rendering the claims vague and indefinite as to what structural limitations applicant intends to encompass with such language

In response to applicants' arguments directed towards Tong, the layer shown in figures 16 and 17 is considered to extend "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the shoe" as claimed. There is no guidance in applicant specification as to the limitations, i.e. what structures/how many spaces/eliminated areas would be encompassed by the term "substantially an entire", especially in view of applicants' arguments that the term "entire" in claim 1 is broad enough to have dependent claims which eliminate the layer in particular areas (i.e. claims 17, 19, and 24) and therefore the layer is not over the "entire" surface. In view of these arguments the limitation and structures applicant

intends to encompass with the term "substantially an entire" is very unclear. Absent any further explicit claimed limitations these terms and other similar broad terms must be interpreted by the examiner in the broadest reasonable manner and the Examiner considers the layer shown in Tong to extend over "substantially an entire" surface as claimed. Tong clearly shows an intermediate layer which extends into the forefoot area (see figures 16 and 17) and since Tong and/or Barry shows all of the positively recited structures, it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971). Element 120 of Tong would clearly and inherently provide torsional rigidity to some degree because of the more rigid material used for the element and there are no slits in the rear section and therefore would clearly provide torsional rigidity at least in the heel region.

14. In response to applicants' argument that one of ordinary skill in the art would know what structures would be encompassed by the phrase "substantially entire" is not true and the confusion, disagreements, and arguments presented in this case are evidence that such is not clear. The Examiner, which is considered to be one of ordinary skill in the art disagrees with applicant as to what is encompassed with this

phrase and considers some of the prior art (as noted in the above rejections) to show such, and applicant does not, therefore it is not clear what structures applicant intends to encompass with such language. Tong appears to show a layer that covers at least 90% of the entire layer and 90% to the Examiner is considered to be substantially the entire surface. Barry appears to show at least 85-90% and since it covers "substantially the entire" surface, due to the more rigid material it does increase torsional rigidity to some degree inasmuch as applicant has claimed such. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974). There appears to be a difference in opinion as to what structures would be encompassed by the phrase "substantially entire" and there is no guidance in the specification as to what said phrase encompasses, the examiner must give these terms their broadest reasonable interpretation.

In response to applicants' arguments directed towards Giese, Giese clearly discloses an upper cushioning layer which is molded above the stabilizing layers (see column 10 lines 1-33). Applicant argues that there no layer above element 31, there is a layer above element 31. In column 10 lines 1-33 Giese clearly stated that the stabilizer element is embedded/integrally molded with the cushioned polyurethane which is specifically referred to in reference to the embodiment shown in figures 122-126 in column 11 lines 39-41. Therefore it is clear and inherent that there is a polyurethane layer above and around element 31.

In response to applicants' arguments directed towards Fukuoka, Fukuoka clearly states that the outsole shown is to be used with "shoes sandals, slippers, etc." (see

column 2 line 66). Also, it is noted that there are many types of sandal sport shoes and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicants' arguments directed towards the "cushioning" layer, elements 29, 33, and 31 are formed from the same material as the bottom layer, i.e. a soft synthetic resin (as discussed in column 4 lines 29-30 and column 3 lines 59-60), due to the use of this material these elements would provide cushioning. Therefore these elements would provide cushioning to some degree. The small hard cores could not negate all of the cushioning of the entire layer of the soft resin areas forming the upper cushion layer.

In response to applicants' arguments directed towards Salzman, the insert of Salzman clearly extends over the entire surface as shown in figures 3 and 6 and described as such in the specification (specifically in the brief description of the drawings). The insert 30 is rigid (see column 2 lines 55-59 and it is clearly shown as covering the entire layer in the drawings). Since it provides torsion rigidity (column 2 lines 55-60, as applicant has argued it must/inherently cover the width of the shoe sole. Also, in figure 3 of Salzman clearly shows portions of the plate as discussed in column 3 lines 1-20 which extends over the entire width of the shoe sole.

In response to applicants' argument that claim 1 requires the ground contacting layer be made from rubber, this is not true, the only recitation of rubber in claim 1 is in a

statement of what is permitted by the structures, i.e. the framework “thereby permitting it to be made of soft, more adherent rubber”, there is no positive recitation that any element is made of rubber, only that a structure is present so as to allow such a use.

In response to applicants’ arguments directed towards Misevich, the ground contacting layer of Misevich is considered to be a laminate formed by elements 46 and 32 and therefore the plate 37 is in contact with this ground contacting layer.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to applicants’ arguments directed towards Kurrash, Kurrash clearly designates element 36 as a relatively hard material (column 2 line 42) which clearly can be considered to be a rigid support layer and inherently will provide some level of torsion control and flexional rigidity due to the relatively hard material used.

In response to applicants’ arguments directed towards the teachings of Hannibal, Hannibal clearly discloses a stiffening layer of a composite/laminate sole which extends over the entire surface of the ground contacting layer of the sole. Hannibal also clearly teaches that the exact placement of the layer does not appear to be exclusive to the location shown (as suggested in column 7 lines 55-63). Hannibal clearly teaches extending a stiffening layer over the entire surface area of a sole.

### ***Reissue Applications***

15. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

16. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 23, 26, and 27 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

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Check out our web-site at "[www.uspto.gov](http://www.uspto.gov)" for fees and other useful information.

A handwritten signature in black ink, appearing to read "Marie Patterson", with a stylized flourish at the end.

Marie Patterson  
Primary Examiner  
Art Unit 3728